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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte F. DEVON TAYLOR, BART DAHNEKE, DALE J. BETHERS,
and BRAD P. CHRISTENSEN

Appeal 2008-2958
Application 09/390,954
Technology Center 3600

Decided: September 5, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

F. Devon Taylor, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-17. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

The invention relates to “printer services that are available on a computer network and, more specifically, to a method and apparatus for efficiently providing accounting support for such network-based print services.” (Specification 1:2-4.) “A typical service provided by a server is a conventional queue-based printing service.” (Specification 1:24-25.) “While this complicated queue-based printing system works well, it is rather time consuming and inefficient in terms of resource consumption. Specifically, the accounting service software on the print server must examine the data stream of a print job in order to perform the appropriate accounting function.” (Specification 2:11-14.) “The invention comprises an application-to-application communication interface between an accounting service application and a printer agent application residing on a computer network. The interface is preferably embodied as novel application programming interface (API) functions or calls between the applications that provide accounting support for print services, including tracking the production of print jobs and the resources consumed by those jobs. The accounting support services provided by the novel API communication interface facilitate computing of charges by the accounting application for

¹ Our decision will make reference to Appellants’ Appeal Brief (“App. Br.”, filed mar. 21, 2007) and Reply Brief (“Reply Br.”, filed Nov. 26, 2007), and the Examiner’s Answer (“Answer,” mailed Sep. 26, 2007).

print services and materials used by print clients.” (Specification 2:20-27.) This is shown schematically in Fig. 3. See also (Specification 8:8-18.) In one embodiment, “the accounting application and printer agent preferably reside on a print server of the network The accounting application registers with the printer agent to provide the agent with, e.g., addresses for the API print service call. A print client on the network submits print jobs directly to the printer agent rather than into queues as in the conventional queue-based printing system. The novel APIs allow the accounting service application to discover and obtain information about the print jobs as they are created and processed by the printer agent. Such information enables the accounting application to leverage use of functions directed to acquiring and setting attributes for these print jobs, thereby extending the utility of those functions for the accounting application.” (Specification 2:28-3:9.)

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A communication interface between an accounting application and a printer agent application executing on a computer network, the interface comprising:

application programming interface (API) functions exchanged and bound between applications that provide accounting support services, wherein the accounting support services are directed to a print job, and the print job is directly received by a printer agent from a print client, the printer agent and the accounting support services reside on a server within a network, and wherein the accounting support services include tracking production of the print job and computer resources consumed by the job, the API functions comprising a first print service API that is called

by the printer agent before the print job is created and sent to a printer and that enables the accounting application to one of reject the print job, accept the print job and instruct the printer agent to place an accounting hold on the print job, and wherein the accounting support services are separate and apart from the printer agent and the printer agent is separate and apart from the printer.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Bennett US 5,146,344 Sep. 8, 1992

The following rejection is before us for review:

1. Claims 1-17 are rejected under 35 U.S.C. §102(b) as being anticipated by Bennett.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-17 under 35 U.S.C. §102(b) as being anticipated by Bennett.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior

art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

We begin by commanding the Examiner for including a claim map (attached to the Answer) showing where in Bennett the Examiner finds each limitation of claim 1 to be described. Implicit in the claim map is the Examiner’s construction of the claim that led the Examiner to equate elements of the claimed interface with those described in Bennett to reach the conclusion that Bennett anticipates the claimed subject matter.

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Anticipation is determined by first construing the claims and then comparing the properly construed claims to the prior art. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1346 (Fed. Cir. 2002). Cf. *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) (“Implicit in our review of the Board’s anticipation analysis is that the claim must first have been correctly construed to define the scope and meaning of each contested limitation.”)

That being said we will not sustain the rejection. We agree with the Appellants that the subject matter of claim 1 requires the presence of a network as is commonly understood by those of ordinary skill in the art and that such a network is not expressly or inherently described in Bennett.

We are faced here with a rejection under §102, not §103. Accordingly, the question is whether Bennett anticipates the claimed subject, not whether it would render the claimed subject matter obvious to one of ordinary skill in the art. For Bennett to be an anticipatory reference, “[t]here

must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). There is no dispute that a network is not expressly described in Bennett, as that term is understood by those of ordinary skill in the art. Accordingly, for Bennett to be anticipatory, Bennett must *inherently* disclose a network. Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

Bennett describes a printing system unconnected to any other computer. A “network” in the context that it is used in claim 1 would be understood by one of ordinary skill in the art to refer to a network that connects computers and not, as Bennett describes, a system of interconnected printed wiring boards (PWBs) (Bennett, col. 5, ll. 31-32).

The claimed subject matter is drawn to a communication interface comprising application program interface (API) functions. The claimed API functions comprise a first print service API that is called by a printer agent residing on a server within a network. Accordingly, the claimed first print service API has a function which is to be able to be called by a printer agent on a server within a network. This is what Bennett must describe to anticipate the claimed subject matter.

The Examiner (claim chart) points to the controller 7 in Bennett as representing a server and PWB 70-9 as representing a printer agent. See

Figs. 2 and 5A of Bennett, respectively. However, we do not see any indication that PWD 70-9 resides on a server in a network. PWB 70-9 is part of the system control (element 54) of the controller section 7 of a laser based printing system 2. As we stated, this is a rejection under §102 where principles of inherency apply. "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient," *Id.* (*citing In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). The missing descriptive matter must, necessarily, be present in the reference and recognized as such by persons of ordinary skill. *Id.* We do not see from Bennett's system that a server within a network is necessarily involved. Nor do we find that one of ordinary skill in the art would recognize the Bennett arrangement as one necessarily involving a server and a network.

Accordingly, we do not find that a printer agent on a server within a network is inherently disclosed in Bennett. Because Bennett does not inherently disclose a printer agent on a server within a network, it follows that Bennett does not inherently disclose the claimed first print service API with a function to be able to be called by a printer agent on a server within a network. That in turn means Bennett does not anticipate the claimed communication interface.

CONCLUSION

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-17 under 35 U.S.C. §102(b) as being anticipated by Bennett.

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Application 09/390,954

DECISION

The decision of the Examiner to reject claims 1-17 is reversed.

REVERSED

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